UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,337	09/16/2003	Keiko Shiraishi	117194	9255

25944   7590   07/22/2009
OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER
PATEL, MANGLESH M

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
07/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/662,337	SHIRAISHI ET AL.
	Examiner	Art Unit	
	MANGLESH M. PATEL	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 May 2009*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-17* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

U.S. Patent and Trademark Office
PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 20090720

DETAILED ACTION

1.   This **Non-Final** action is responsive to the Pre-Appeal Conference filed 5/1/2009 (Note: prosecution has been

reopened).

2.   In the amendment claims 1-17 remain pending. Claims 1, 10, 11, 12, 13, 16 and 17 are the independent claims.

Withdrawn Rejections

3.   The 35 U.S.C. 102(a) rejections of claims 1-17 with cited reference of Tatsuo (EP 1, 286 254 A2) has been withdrawn

in light of the persuasive arguments.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under

this section made in this Office action:

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States
> before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled
> the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the
> applicant for patent.

5.   Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (U.S. 6,782,379, filed Nov. 30, 2001).

Regarding Independent claims 1, 10, 13 and 16, An instruction form retrieval apparatus comprising: A storage part

that stores user information and information on an instruction form management apparatus that is connected to the

instruction form retrieval apparatus via a network and is holding an at least one selectable instruction form associated

with a user based on user access rights, wherein the instruction form is generated in advance, the instruction form and

the user information being associated with each other wherein the instruction form includes instructions and indicates a

plurality of processing to be executed by a plurality of instruction form execution apparatuses, and is different than any

file to be processed by the instructions; A reception part that receives information on a user; A retrieval part that

retrieves the instruction form accessible to the user from the instruction form management apparatus based on the

received information on the user. An output part that outputs identification information on the retrieved instruction

form to allow the user to instruct performing a process indicated in the instruction form to one or more instruction form

execution apparatuses connected to the instruction form retrieval apparatus via the network.

Lee discloses a storage part that stores user information and information on a management apparatus connected through a network (see fig 57 disclosing in numeral 2212 certificate Registration Module that authenticates a requesting User). The apparatus includes a selectable instruction form as templates and are based on user access rights as shown in fig 6 numeral 300 wherein the user requests access which is then intercepted by web pass. See column 7, lines 28-35 which discloses access privileges. Furthermore the Identity system holds selectable forms based on user access rights such as the certificate registration information (see column 9, lines 17-22). The instruction forms are the plurality of XML templates already generated in advance and which provide a plurality of instructions for the execution apparatuses or devices for displaying content (column 2, lines 15-45). He discloses an output part that outputs Identification information on the retrieved template (see column 26, lines 30-60). After authentication the system allows the user to create a workflow which includes identification information, the workflow or instructions is based on the template to determine which actions can be added. Therefore Lee teaches an output part that outputs identification information (as an ID associated with the workflow generated from the instruction form) thereby allowing the user to instruct performing a process such as actions defined in the templates.

Regarding Dependent claim 2, with dependency of claim 1, Lee discloses wherein the output part outputs the Identification information on the retrieved instruction form to the instruction form execution apparatus used by the user (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

Regarding Dependent claim 3, with dependency of claim 1, Lee discloses wherein the output part outputs the Identification information on the instruction form to a terminal used by the user (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

Regarding Dependent claim 4, with dependency of claim 1, Lee discloses wherein the output part outputs a command to the instruction form management apparatus to transmit the instruction form accessible to the user to the instruction form execution apparatus used by the user, based on the Identification information on the retrieved instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

Regarding Dependent claim 5, with dependency of claim 1, Lee discloses wherein the output part outputs a command to the instruction form management apparatus to transmit the instruction form accessible to the user to a terminal used

by the user, based on the Identification information on the retrieved instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

Regarding Dependent claim 6, with dependency of claim 1, Lee discloses wherein the outputted Identification information on the retrieved instruction form is information on the instruction form management apparatus holding the instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

Regarding Dependent claim 7, with dependency of claim 1, Lee discloses wherein the outputted Identification information on the retrieved instruction form includes information to identify the instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

Regarding Dependent claim 8, with dependency of claim 1, Lee discloses wherein user authentication is performed using the information on the user (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

Regarding Dependent claim 9, with dependency of claim 1, Lee discloses a display information generation part that generates information to display the information on the retrieved instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

Regarding Independent claims 11 and 12, An instruction form execution apparatus comprising: an attachment part that attaches a portable storage , medium which is unique to and capable of being carried by a predetermined user, the storage medium holding information on a plurality of instruction form management apparatuses holding at least one selectable instruction form associated with the user based on user access rights, wherein the instruction form is generated in advance, wherein the instruction form includes instructions and indicates a plurality of processing to be executed by a plurality of instruction form execution apparatuses and is different than any file to be processed by the instructions; and an execution part that executes a plurality of processing instructions indicated in the instruction form, wherein the at least one selectable instruction form is located on at least one server.

Lee discloses a storage part that stores user information and information on a management apparatus connected through a network (see fig 57 disclosing in numeral 2212 certificate Registration Module that authenticates a requesting User).

The apparatus includes a selectable instruction form as templates and are based on user access rights as shown in fig 6 numeral 300 wherein the user requests access which is then intercepted by web pass. See column 7, lines 28-35 which discloses access privileges. Furthermore the Identity system holds selectable forms based on user access rights such as the certificate registration information (see column 9, lines 17-22). The instruction forms are the plurality of XML templates already generated in advance and which provide a plurality of instructions for the execution apparatuses or devices for displaying content (column 2, lines 15-45). He discloses an output part that outputs Identification information on the retrieved template (see column 26, lines 30-60). After authentication the system allows the user to create a workflow which includes identification information, the workflow or instructions is based on the template to determine which actions can be added. Therefore Lee teaches an output part that outputs identification information (as an ID associated with the workflow generated from the instruction form) thereby allowing the user to instruct performing a process such as actions defined in the templates.

Regarding Dependent claim 14, with dependency of claim 13, Lee discloses wherein the information on the retrieved instruction form is outputted to the instruction form execution apparatus used by the user (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

Regarding Dependent claim 15, with dependency of claim 13, Lee discloses outputting a command to the instruction form management apparatus to transmit the instruction form accessible to the user to the instruction form execution apparatus used by the user, based on the information on the retrieved instruction form (See abstract & column 2, lines 15-45, including the explanation provided in the independent claims).

Regarding Independent claim 17, An instruction form execution apparatus comprising: an attachment part that attaches a portable storage medium capable of being carried by a user that stores at least one selectable instruction form that includes processing instructions associated with the user based on user access rights, wherein the instruction form is generated in advance, wherein the instruction form indicates a plurality of processing to be executed by a plurality of instruction form execution apparatuses and is different than any file to be processed by the processing instructions; and a processing part that executes the processing instructions based on the instruction form to process information not stored in the storage medium.

Lee discloses a storage part that stores user information and information on a management apparatus connected through a network (see fig 57 disclosing in numeral 2212 certificate Registration Module that authenticates a requesting User). The apparatus includes a selectable instruction form as templates and are based on user access rights as shown in fig 6 numeral 300 wherein the user requests access which is then intercepted by web pass. See column 7, lines 28-35 which discloses access privileges. Furthermore the Identity system holds selectable forms based on user access rights such as the certificate registration information (see column 9, lines 17-22). The instruction forms are the plurality of XML templates already generated in advance and which provide a plurality of instructions for the execution apparatuses or devices for displaying content (column 2, lines 15-45). He discloses an output part that outputs Identification information on the retrieved template (see column 26, lines 30-60). After authentication the system allows the user to create a workflow which includes identification information, the workflow or instructions is based on the template to determine which actions can be added. Therefore Lee teaches an output part that outputs identification information (as an ID associated with the workflow generated from the instruction form) thereby allowing the user to instruct performing a process such as actions defined in the templates.

It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references <u>should not be considered to be limiting in any way.</u> A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. [[See, MPEP 2123]]

Response to Arguments

6.   Applicant's arguments filed 5/1/2009 have been fully considered but are moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M, W 6 am-3 pm T, TH 6 am-2pm, Fr 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval

(PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the

PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel
Patent Examiner (AU 2178)
July 17, 2009

/Manglesh M Patel/
Manglesh Patel
Examiner, Art Unit 2178

| | /CESAR B PAULA/ |
| | Primary Examiner, Art Unit 2178 |